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10/652,372

08/29/2003

Enno Adema

03-769

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10/03/2007

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EXAMINER

FOSTER, CHRISTINE E

ART UNIT

PAPER NUMBER

1641

MAIL DATE

DELIVERY MODE

10/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/652,372

Applicant(s)

ADEMA, ENNO

Examiner

Christine Foster

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or.
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2, 4 and 6-12.
Claim(s) withdrawn from consideration: 3 and 5.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


LONG V. LE 09/21/07
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Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejections of claims 13-15 under 35 USC 102(b) are withdrawn in view of the claims' cancellation.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments have been fully considered but are not persuasive of error. With respect to the rejections of claims 1-2, 4, 6-7, and 11-12 under 35 USC 103(a) as being unpatentable over Plattner et al. in view of Furatu, Morris et al., and Akhavan-Tafti et al., Applicant argues that Furatu, Morris, and Akhavan-Tafti relate to measurement of different analytes, and that none of the references teach sequential detection of the same analyte as presently claimed (see Reply, pages 4-5).

This is not found persuasive because it amounts to a piecemeal analysis of the references. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In the instant case, the teaching of performing multiple measurements relating to the same analyte is found in the primary reference, as Plattner et al. teach determining both total AT-III activity as well as "progressive anti-thrombin activity" measured in the absence of heparin. Although Plattner et al. fail to specifically teach performing these two measurements sequentially (on the same sample), motivation to perform multiple measurements on a single sample in series (rather than in parallel) is found variously in the Furatu, Morris, and Akhavan-Tafti measurements. Therefore, whether the secondary references relate to performing multiple measurements of the same or of different analytes is seen as tangential to the issue at hand, since the relevant teaching is found in the primary reference.

Although the secondary references do appear to relate to measurement of different analytes, while in the instant case a single analyte is under study, the test for obviousness involves consideration of what the combined teachings, as opposed to the individual teachings, of the references would have suggested to those of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In the instant case, it is maintained that one of ordinary skill would have appreciated that the art-recognized advantages in performing multiple measurements on a single sample would be particularly pertinent to the method of Plattner et al., which involves performing multiple measurements.

Applicant further argues that the Examiner has not articulated any pertinent and specific reasoning that would lead one to determine AT sequentially in the same sample (Reply, pages 5-6), to which the Examiner disagrees for reasons of record as set forth in the previous Office action at page 6, the first paragraph.

With respect to the rejections of dependent claims 8-10, Applicant does not separately argue the limitations of the dependent claims.

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